

Attorney Docket: 030441
U.S. Application No. 10/786,733 Examiner Watson Art Unit 3723
RCE in Response to October 9, 2007 Final Office Action

REMARKS

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In response to the final office Action dated October 9, 2007, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

Claims 1, 3, 11, 13, 19, and 21-23 are pending in this application. Claims 2, 12, and 20 were previously canceled, and claims 4-10, 14-18 were withdrawn by restriction.

Insertion of New Paragraph

The Assignee respectfully requests an insertion of a new paragraph into the specification. This new paragraph describes the features shown in FIGS. 5 and 5A. Because these features were already shown in FIGS. 5 and 5A, the Assignee respectfully asserts that no new matter is being inserted.

Objection to the Drawings

The Office objected the drawings, alleging that the combination of the longitudinal portion with the spiral groove with the end portion having a plurality of grooves together must be shown or canceled. The Office alleges, in particular, that there is ambiguity in how to combine FIG. 5 with FIG. 8. Because the claims combine the structure in FIGS. 5 and 8, then the Office alleges that the drawings must show this structural combination.

The Assignee, however, respectfully requests reconsideration. Paragraph [0023] expressly explains “[t]he end portion 51 comprising the grooves 53 can be fixedly attached to the an *sic* end portion of the fish tape ... or it can be integrally formed therewith.” FIGS. 5 and 8 show, respectively, the end portion and the longitudinal portion, and the paragraph [0023] explains that these two portions are attached. The Assignee thus respectfully asserts that there is

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no ambiguity and that the claimed features are shown. The Office is thus respectfully requested to remove the objection.

Rejection of Claims Under 35 U.S.C. § 112, second paragraph

Claims 1, 3, 11, 13, 19, and 21-23 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. The test for indefiniteness is whether one of ordinary skill in the art would understand what is claimed when “read in light of the specification.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2173.02 (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081, 1088 (Fed. Cir. 1986)). Using this test, the Assignee is confident that one of ordinary skill in the art, after reading the specification, will understand what is claimed. All the independent claims recite “*an end portion attached to an end of the longitudinal portion.*” Support may be found at least at paragraph [0023] (explaining “[t]he end portion 51 comprising the grooves 53 can be fixedly attached to the an *{sic}* end portion of the fish tape ... or it can be integrally formed therewith”). The Assignee thus respectfully requests removal of this rejection.

Rejection of Claims Under 35 U.S.C. § 112, first paragraph

Claims 1, 3, 11, 13, 19, and 21-23 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to comply with the enablement requirement. Again, though, the Assignee respectfully requests reconsideration of this rejection. The claims do not recite that “wires are to be attached to the fish tape such that the wires can be pulled by the fish tape.” On the contrary, the claims similarly recite “*the pair of radially opposed grooves in the end portion provide one or more mechanisms for attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape*” (emphasis added). It is the “engaging attachments” that are attached to the pair of radially opposed grooves. The Assignee thus respectfully requests removal of this rejection.

Rejection of Claims Under 35 U.S.C. § 103 (a)

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Claims 1, 3, 11, 13, 19, and 21-23 were rejected under 35 U.S.C. § 103 (a) as allegedly being obvious over U.S. Patent 5,505,432 to Noonan in view of U.S. Patent 4,926,518 to Mikol and further in view of U.S. Patent 5,938,180 to Walsten.

The proposed combination of *Noonan*, *Mikol*, and *Walsten*, however, cannot obviate these claims. These claims recite, or incorporate, many features that are not disclosed or suggested by *Noonan*, *Mikol*, and *Walsten*. Independent claim 1, for example, recites "*an end portion attached to an end of the longitudinal portion, the end portion having a pair of radially opposed grooves extending from a terminal end of the end portion along a length of the end portion, each groove longitudinally extending along an outer surface of the end portion, each groove having a radial surface width that defines an open slot at the outer surface of the end portion, each groove having a bottom floor at a depth from the outer surface, the bottom floor having a floor width that is greater than the radial surface width, the bottom floor also having a convex shape such that a radius of the bottom floor is smaller than and concentric to an outer radius of the end portion.*" Support for such features may be found at least in the as-filed application at FIGS. 5 and 5A. Independent claims 11 and 19 recite similar features.

Noonan, *Mikol*, and *Walsten* cannot obviate all these features. *Noonan* describes a fish tape with an anti-snagging roller. *Mikol* discloses an auger for cleaning drains. *Walsten* describes a fish tape that threads to a ferrule. Still, though, the proposed combination of *Noonan*, *Mikol*, and *Walsten* fails to teach or suggest "*an end portion attached to an end of the longitudinal portion, the end portion having a pair of radially opposed grooves extending from a terminal end of the end portion along a length of the end portion, each groove longitudinally extending along an outer surface of the end portion, each groove having a radial surface width that defines an open slot at the outer surface of the end portion, each groove having a bottom floor at a depth from the outer surface, the bottom floor having a floor width that is greater than the radial surface width, the bottom floor also having a convex shape such that a radius of the bottom floor is smaller than and concentric to an outer radius of the end portion.*" Because the

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combined teaching of *Noonan, Mikol*, and *Walsten* fails to teach or suggest all these features, the independent claims cannot be obviated by *Noonan, Mikol*, and *Walsten*.

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Claims 1, 3, 11, 13, 19, and 21-23, then, are not obvious. The independent claims recite many features that are not taught or suggested by *Noonan, Mikol*, and *Walsten*. The dependent claims incorporate these same distinguishing features. One of ordinary skill in the art, then, would not think that claims 1, 3, 11, 13, 19, and 21-23 are obvious. The Office is respectfully requested to remove the § 103 (a) rejection of these claims.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,



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